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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/654,433	09/03/2003	Luciano M. Parrinello	1687P2	5223

7590

07/05/2005

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EXAMINER

JACKSON, MONIQUE R

ART UNIT

PAPER NUMBER

1773

DATE MAILED: 07/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/654,433

Applicant(s)

PARRINELLO ET AL.

Examiner

Monique R Jackson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-109 is/are pending in the application.
- 4a) Of the above claim(s) 18-109 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>11/03</u> . | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Election/Restrictions

1. Applicant's election without traverse of Group I, Claims 1-17 in the reply filed on 6/3/05 is acknowledged. Claims 18-109 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected inventions, there being no allowable generic or linking claim.

Terminal Disclaimer

2. The terminal disclaimers filed on 1/31/05 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of any patents issuing from 10/411,311 or 10/319,326 or 10/654377, have been reviewed and are accepted. The terminal disclaimer has been recorded. Accordingly, the double patenting rejections recited previously have been overcome.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tashiro et al (USPN 6,821,584.) Tashiro et al teach an ink jet recording medium comprising first and second ink jet absorbing layers wherein the surface absorbing layer is formed from an aqueous coating composition having a pH within the instantly claimed range, and preferably not more than 4, wherein the coating composition comprises gelatin and a cationic polymer in the amount of 1-

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20wt%, and may further include other water soluble polymers in an amount of 10-70wt%, wherein these polymers may be selected from a wide variety of known water soluble polymers with example coating dispersions including polyurethane (Abstract; Col. 4, lines 21-27; Col. 11, lines 23-33; Col. 13, lines 15-38; Col. 30-31; Examples.) Tashiro et al further teach that the cationic polymer may be a nitrogen containing cationic polymer with suitable polymers including polymers that read upon the instantly claimed dye fixative compound, such as polyamide-epichlorohydrin polymers and polymers formed from the instantly claimed monomers (Col. 6, line 53-Col. 11, lines 22.) The main difference between the prior art and the instant invention is that the prior art discloses a variety of water soluble polymers and does not specifically limit the invention to the polyurethane polymers as instantly claimed. However, considering Tashiro teaches that polyurethane resins may be utilized in the coating composition, it would have been obvious to one having ordinary skill in the art at the time of the invention to include a polyurethane resin in the coating composition as taught by Tashiro. Further, it is noted that water soluble polyurethane resins as instantly claimed are obvious species of water soluble resins utilized in ink receiving layer and hence it would have been obvious to include aqueous polyurethane resins as instantly claimed. Further, though Tashiro teaches that the composition includes the cationic resin in an amount of 1-20wt% and the other water soluble resin in an amount of 10-70wt%, and may also include various other materials or additives including viscosity modifiers, one having ordinary skill in the art at the time of the invention would be motivated to determine the optimum amounts of the various components taught by Tashiro based on the desired end use of the coated substrate. Further, one skilled in the art would have been

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motivated to determine the optimum solids content and viscosity to provide the desired coating thickness for a particular end use.

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Noguchi et al (USPN 6,001,466 teaches a coating composition for a printing medium comprising nitrogen containing cationic resin particles and a binder resin that may be an emulsifiable polyurethane. Kondo et al (USPN 5,320,897) teaches an aqueous coating composition comprising a water dispersible resin that may be polyurethane and a nitrogen-containing cationic dye binder.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Monique R Jackson whose telephone number is 571-272-1508. The examiner can normally be reached on Mondays-Thursdays, 8:00AM-4:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carol Chaney can be reached on 571-272-1284. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Monique R. Jackson
Primary Examiner, TC 1700
June 27, 2005